

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q80281

Hideo MATSUNAGA, et al.

Appln. No.: 10/802,874

Group Art Unit: 3711

Confirmation No.: 5453

Examiner: Sebastiano PASSANITI

Filed: March 18, 2004

For: GOLF CLUB HEAD

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated May 12, 2009. Entry of this Reply Brief is respectfully requested.

Table of Contents

STATUS OF CLAIMS.....	2
GROUND OF REJECTION TO BE REVIEWED ON APPEAL.....	3
ARGUMENT.....	4
CONCLUSION.....	8

STATUS OF CLAIMS

Claims 1-20 are all the claims pending in the application.

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsuchiya et al. (U.S. Patent No. 5,346,217; hereinafter “Tsuchiya”) in view of Motomiya (U.S. Patent No. 4,438,931; hereinafter “Motomiya”), Hoshi (U.S. Patent No. 5,205,560; hereinafter “Hoshi”), Tsuchida (U.S. Patent No. 5,255,913; hereinafter “Tsuchida”), Kusumoto (U.S. Patent No. 6,634,958; hereinafter “Kusumoto”), Murphy (U.S. Patent No. 6,332,847; hereinafter “Murphy”), Dekura (U.S. Patent No. 5,538,246; hereinafter “Dekura”) and Imai (U.S. Patent No. 6,056,649; hereinafter “Imai”).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsuchiya et al. (U.S. Patent No. 5,346,217; hereinafter “Tsuchiya”) in view of Motomiya (U.S. Patent No. 4,438,931; hereinafter “Motomiya”), Hoshi (U.S. Patent No. 5,205,560; hereinafter “Hoshi”), Tsuchida (U.S. Patent No. 5,255,913; hereinafter “Tsuchida”), Kusumoto (U.S. Patent No. 6,634,958; hereinafter “Kusumoto”), Murphy (U.S. Patent No. 6,332,847; hereinafter “Murphy”), Dekura (U.S. Patent No. 5,538,246; hereinafter “Dekura”) and Imai (U.S. Patent No. 6,056,649; hereinafter “Imai”).

ARGUMENT

In the Appeal Brief, the Appellant submitted that Kusumoto, Murphy, Dekura, and Imai fail to disclose the claimed intersection angle between the crown portion and the side portion being larger than 90 degrees, in combination with other elements of claim 1. Since the detailed descriptions of these cited references do not expressly mention the intersection angle being larger than 90 degrees, the Examiner maintains his position that the drawings of Kusumoto, Murphy, Dekura and Imai allegedly disclose the claimed intersection angle.

Appellant also pointed out in the Appeal Brief that the above references' complete silence on the claimed intersection angle and weight of Federal Circuit case law, i.e., Go Medical¹, Nystrom², and Hockerson-Halberstadt³, all show that the Examiner's position is without support. In response, the Examiner continues to rely on Section 2125 of the M.P.E.P. citing case law whose holdings actually support Appellant's position or of limited precedential value.

As completely explained on pages 15-19 of the Appellant's Brief, Go Medical, Nystrom, and Hockerson-Halberstadt, establish without doubt that patent drawings do not define precise proportions of the elements. In response, the Examiner has not provided any evidence to show

¹ Go Medical Indus. Pty., Ltd. v. Inmed Corp., 471 F.3d 1264, 1271 (Fed. Cir. 2006).

² Nystrom v. TREX Co., 424 F.3d 1136, 1149 (Fed. Cir. 2005).

³ Hockerson-Halberstadt, Inc. v. Avia Group Int'l, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (cited in MPEP 2125).

that drawings of Kusumoto, Murphy, Dekura and Imai are drawn to scale to provide support for the Examiner's position.

Moreover, the Examiner does not provide any authority which would trump the Federal Circuit case law cited by the Appellant, but continues to rely on Section 2125 of the M.P.E.P. citing dated cases whose holdings are at least significantly constrained by Go Medical, Nystrom, and Hockerson-Halberstadt.

In Section 2125, the M.P.E.P. cites In re Mraz⁴, Jockmus v. Leviton⁵, and In re Aslanian⁶. Appellant points out that Mraz was cited only once by the Federal Circuit and thrice by this Board, all for holdings which are irrelevant to this appeal.⁷ Similarly, Jockmus was cited only once by the Federal Circuit and once by this Board, and In re Aslanian was cited only once by the Federal Circuit - and never by this Board - for holdings having no bearing on this appeal.⁸

⁴ 455 F.2d 1069, 173 U.S.P.Q. (BNA) 25 (C.C.P.A. 1972).

⁵ 28 F. 2d 812 (2nd Cir. 1928).

⁶ 590 F.2d 911, 200 U.S.P.Q. (BNA) 500 (C.C.P.A. 1979).

⁷ See Muniauction, Inc. v. Thomson Corp., 532 F.3d 1318, 1328 (Fed. Cir. 2008) (citing In re Mraz to explain that claims which read on obvious subject matter are unpatentable even if they also read on nonobvious subject matter); Ex parte Anderson et al., 21 U.S.P.Q.2d (BNA) 1241, 1991 Pat. App. LEXIS 12, 86 (Pat. & Trademark Office Bd. App. 1990) (citing In re Mraz for defining scope of patentable chemical compositions); Ex parte Westphal, 26 U.S.P.Q.2d (BNA) 1858, 1864 (Bd. Pat. App. & Interferences Apr. 30, 1992) (citing In re Mraz for distinguishing rejections under 35 U.S.C. § 103 and 35 U.S.C. § 112); and In re Haas, 175 U.S.P.Q. (BNA) 217, 221 (Pat. & Trademark Office Bd. App. & Interferences 1972) (citing In re Mraz for discussion on which actions of an Examiner are subject to appeal)

⁸ See In re Klopfenstein, 380 F.3d 1345, 1351 (Fed. Cir. 2004) (citing Jockmus for explaining what constitutes a "printed publication"); and Gullicksen v. Halberg, 75 U.S.P.Q. (BNA) 252 (Pat. & Trademark Office Bd. App. & Interferences 1972) (footnote continued)

Appellant submits that the zero subsequent citations of Mraz, Jockmus and Aslanian at the Federal Circuit and by this Board for holdings relevant to this appeal reflects their obsolescence or their limited applicability to present day patent law.

If assuming arguendo, that these cases are of precedential value, Appellant submits that Mraz supports the Appellant's position that the claimed intersection angle is not disclosed by the cited references.

Mraz is cited for the holding that "[d]rawings and pictures can anticipate claims if they clearly show the structure which is claimed."⁹ In the decision, the court explained that drawings of a prior art reference showing the claimed angle property renders it "old" but qualified this holding:

Here, Fig. 3 in the Wilson reference focuses on the edge rolls, showing them with great particularity and showing the grooves thereon to have an angularity well within the range recited in appellant's claims. Wilson, therefore, shows this aspect of subject matter lying within appellant's claims to be old.¹⁰

To wit, the Wilson reference described in particularity the part of the disclosure – the edge rolls - which was cited as corresponding to the claimed groove angle. This showing in particularity was

Trademark Off. Bd. App. & Interferences 1937) (same). See Tone Bros. v. Sysco Corp., 28 F.3d 1192, 1199 (Fed. Cir. 1994) (citing In re Aslanian for explaining that a "design may embody function features and still be patentable . . .").

⁹ 455 F.2d 1069, 173 U.S.P.Q. (BNA) 25 (C.C.P.A. 1972).

¹⁰ Mraz at 1072 (emphasis added).

not only the drawings, but also in the detailed description section of the specification.¹¹ Hence, the edge rolls were pointed out by the court as providing support for the court's holding that Wilson's edge rolls rendered the claimed groove angle to be "old."¹²

In contrast, none of the references cited by the Examiner show with any particularity the intersection angle of the crown portion and the side portion to support the Examiner's position that these reference disclose the claimed intersection angle.

As for the Examiner's comments that the Appellant has the burden to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product, Appellant submits that the Examiner has not provided a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, for the burden to shift to the Appellant. Since the claimed intersection angle is not disclosed or suggested by Kusumoto, Murphy, Dekura and Imai, the burden still remains on the Examiner to provide the rationale to show that the claimed product is the same or similar to the cited references.

Lastly, the Examiner appears to state that claim 16's recitation of a golf club "wherein the upper side portion has a Young's modulus lower than the lower side portion and the hosel portion," is disclosed because the references mention the crown portion has having a Young's modulus that differs from other portion of the club head.

¹¹ U.S. Patent No. 2,326,715, issued to Wilson et al., page 2, column 1, lines 26-35.

¹² Mraz at 1072.

Appellant disagrees because the Examiner is improperly importing limitations into claim 16 from the specification and not properly addressing the recitations of claim 16. Nowhere in claim 16 is there any mention of the crown portion and the upper side portion being made from the same piece of material so that the Young's modulus would be the same for both portions. Rather, the claim merely compares the Young's modulus between two parts of the side portion and the Examiner has not shown how any of the references show such claimed features.

For at least the above reasons and for the reasons submitted in Appellant's Appeal Brief, Appellant submits that claims 1-20 are patentable.

CONCLUSION

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,
/ S. Stuart Lee /

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON DC SUGHRUE/265550

65565

CUSTOMER NUMBER

Date: July 13, 2009

S. Stuart Lee
Registration No. 61,124